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10/763,796

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EXAMINER

TRAN, THUAN Q

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/763,796	<b>Applicant(s)</b> DRAKE, STEPHEN	
	<b>Examiner</b> Thuan Tran	<b>Art Unit</b> 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-5-2009</u>  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the Amendment filed on 3-5-2009.
2. Claims 1, 5, 6, 11-13, 19, and 23 are currently amended.
3. Claim 10 is cancelled.
4. Claims 1-9 and 11-39 are currently pending and have been examined.

### ***Response to Arguments***

5. Applicant's arguments, filed 3-5-2009, with respect to previous 35 USC 112 rejections have been fully considered and are persuasive. The previous 35 USC 112 rejections have been withdrawn.
6. Applicant's arguments filed 3-5-2009 with respect to the previous 35 USC 101 rejection have been fully considered but they are not persuasive. Exchanging taxable income for a Taxable loan is not considered transforming an article. This is seen as simply exchanging one income flow for a different type of income flow. Further the invention does not fall into a statutory class. If this method is run on a computer, the process claim must be tied to a particular apparatus in another statutory class. See further detailed 35 USC 101 rejection below.
7. Applicant's arguments with respect to claims 1-9 and 11-39 have been considered but are moot in view of the new ground(s) of rejection. Specifically:
8. Rejections to claims 11, 23, 25, and 27 have been further detailed below.

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9. Applicant states that “PLR does not teach or suggest deferring only a portion of the monetary benefits, as required by claim 4.” A similar argument is given for claim 20. The examiner disagrees. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). PLR teaches what is done with the deferred portion of the income. However, as described below, McCain teaches splitting the income into the deferred and non-deferred portions.

10. The remainder of applicant's arguments stem from the previous absence of a loan to the payee. These arguments are moot in view of the new ground(s) of rejection.

#### ***Information Disclosure Statement***

11. The information disclosure statement (IDS) submitted on 3-5-2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 112***

12. The previous 35 USC 112 rejections to the claims are withdrawn.

#### ***Claim Rejections - 35 USC § 101***

13. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-9 and 11-39** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). The independent claim states method steps such as “creating,” “receiving,” “making,” “providing,” “withholding,” “arranging,” “deducting,” “loaning,” and “distributing.” However this is not sufficient to tie the process claim to a particular apparatus in another statutory class. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps (*In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008)).

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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15. **Claims 1-11, 13-31, 33-39** are rejected *as interpreted by the examiner above* under 35 U.S.C. 103(a) as being unpatentable over Private Letter Ruling 199908006 (PLR) in view of McCain, US 2002/0004771, in further view of Burgess, US Patent 5,966,693 in further view of Notice 2001-10.

16. **As per claim 1, 2, 3, 4, 10, 16, 17, 19, 20, 24 and 25:**

PLR teaches:

- creating a deferred income account (Trust) for the tribal member (see at least page 2 paragraph 5 that starts with “Pursuant to authority”);
- receiving into the deferred income account a deferred portion of a first one of the plurality of monetary payments in order to increase a balance of the deferred income account (see at least page 1 paragraph 8 that starts with “Under Plan A”);
- after the death of the tribal member, distributing the balance of the deferred income account to the one or more beneficiaries of the tribal member in a plurality of periodic payments (see at least page 1 paragraph 8 that starts with “Under Plan A,” item (a)(ii)),
- identifying a payout amount (lump sum) for the tribal member (see at least page 1 paragraph 8 that starts with “Under Plan A”);
- after receiving the deferred portion of the first one of the plurality of monetary payments, using a first portion of the balance of the deferred income account to obtain the payout amount (see at least page 1 paragraph 8 that starts with “Under Plan A”);

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- after a death of the tribal member, distributing the payout amount to one or more beneficiaries of the tribal member (see at least page 1 paragraph 8 that starts with “Under Plan A”);

Although PLR teaches a Tribe creating and depositing into a deferred income account of a tribal member, it does not specifically teach that deferring a portion of the monetary payment to lower tax rate; it further does not teach making a payout using a loan paid by an insurance policy. However, McCain teaches a deferred income system to lower tax rate and Burgess teaches combining a loan with life insurance as described below.

McCain teaches:

wherein:

- for each of the plurality of monetary payments, a difference between the monetary payment and the deferred portion is a non-deferred portion for the monetary payment (see at least paragraph 0080);
- the non-deferred portion for the monetary payment is paid to the *payee* upon payment by the *payor* of the monetary payment (see at least paragraph 0080);
- for each of the plurality of monetary payments, the non-deferred portion for the monetary payment is subject to a lower tax rate than is the monetary payment (see at least paragraph 0087, 0015, and 0016, using the tax shelter produces the lower tax rate); and

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Examiner Notes: McCain paragraph 0080 teaches "to defer at least some portion of the employee's salary" means that there is a deferred and non-deferred portion of the salary (monetary payment).

- after receiving the deferred portion of the first one of the plurality of monetary payments, deducting an expense amount (maintenance costs) from the balance of the deferred income account (see at least paragraph 0088);
- repeating (periodic obligations) the receiving and deducting steps for subsequent ones of the plurality of monetary payments (see at least paragraph 0091);

It would have been obvious to one of ordinary skill in the art at the time of the invention to produce a system for Indian tribes to provide a deferred income account to lower taxes with motivation to create both a tax shelter and a creditor shield for a payor and payee, see at least McCain paragraph 0087.

Burgess teaches:

- providing an insurance policy on a life of the payee, the insurance policy having a death benefit (see at least column 4 line 43-55);
- periodically withholding an insurance payment from the balance of the deferred income account to make a premium payment for the insurance policy (see at least column 4 line 43-55 and column 4 line 66 to 5 line 6, seven yearly payments to meet insurance premium installments);
- the principal amount of the loan is paid after the death of the *payee* out of the death benefit from the insurance policy (see at least column 4 line 56-58).



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It would have been obvious to one of ordinary skill in the art at the time of the invention to produce a system for Indian tribe members to defer income then extract the funds through a loan from the payor using an insurance policy as collateral with motivation to legally avoid unnecessary taxation while permitting the transfer of value from a payor to payee, see at least Burgess column 4 line 21-25.

Although Burgess teaches that the employer makes premium payments to aid in covering the cost of the insurance policy, see at least column 4 line 43-44, he does not specifically state that these payments are loans. However, Notice 2001-10 teaches that these payments are considered by the IRS to be loans from the employer to the employee, see at least column 1 paragraph 2. Together Burgess and Notice 2001-10 teach:

- loaning a principal amount to the *payee* (see at least Burgess column 4 line 43-55 and Notice 2001-10 column 1 paragraph 2)

Both Burgess and Notice 2001-10 describe split dollar life insurance arrangements. It would have been obvious to one of ordinary skill in the art at the time of the invention to further define the split dollar arrangement of Burgess with the IRS's opinion on split dollar life insurance arrangements with motivation to ensure proper tax accounting in accordance with tax laws.

**17. As per claims 5, 6, 21, 35 and 39:**

PLR further teaches:

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- the first entity and the second entity do not have an employer-employee relationship 5 during a time at which the receiving and deducting steps occur (see at least page 1 paragraph 6 starting with “The information further states,” the per capita benefits are from the birth right of the member born into the tribe).
- The plurality of monetary payments and the balance of the deferred income account distribution to the one or more beneficiaries of the tribal member are not subject to an employment tax (see at least page 1 paragraph 6 starting with “The information further states,” the per capita benefits are from the birth right of the member born into the tribe).
- the second entity does not receive any portion of any of the plurality of monetary payments in exchange for work performed for the first entity during a time at which the receiving and deducting steps occur (see at least page 1 paragraph 6 starting with “The information further states,” the per capita benefits are from the birth right of the member born into the tribe).

**18. As per claims 7 and 30:**

Burgess further teaches:

- advising the second entity/tribal member regarding a value of one or more of the deferred portions (see at least column 5 line 19-22, advises on proper contribution level to ensure compliance with tax regulations).

**19. As per claims 8 and 31:**

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Burgess further teaches:

- advising the second entity/tribal member regarding a value of one or more of the deferred portions comprises: advising the second entity/tribal member regarding tax consequences of various values of the one or more of the deferred portions (see at least column 5 line 19-22, advises on proper contribution level to ensure compliance with tax regulations).

**20. As per claim 9:**

PLR further teaches:

- investing an investment portion (benchmark investments) of the deferred income account (see at least page 2 paragraph 5 starting with “pursuant to authority”).

**21. As per claim 11 and 23:**

Burgess further teaches:

- making an investment in a third party (see at least column 1 line 32-34 and column 4 line 43-55), wherein

Examiner notes: The limitations of the claims do not specify that the third and first party must be separate. Thus, the first and second party maybe understood to be one and the same. Column 1 line 32-34 teaches an employer providing such insurance alone means that the employer is also acting as the insurance company. Thus, any investment into the insurance policy, as described in at least column 4 line 43-55, is also an investment into the employer.

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Notice 2001-10 and Burgess further teach:

- the third party makes the loan for the principle amount to the second entity (see at least Burgess column 4 line 43-55 and Notice 2001-10 column 1 paragraph 2).

Burgess teaches that the employer makes premium payments for the insurance product and Notice 2001-10 clarifies that these payments are understood to be a loan from the employer to the employee.

**22. As per claims 13 and 33:**

Burgess further teaches:

- the loan is not secured by the deferred income account (see at least column 4 line 56-58, loan is secured by policy).

**23. As per claims 14 and 34:**

Burgess further teaches:

- the loan is secured using at least one of the non-deferred portions of the plurality of monetary payments that has not been paid by the first entity/Indian Tribe to the second entity/Tribe member at a time when the loan is made (see at least column 4 line 56-58, loan is secured by policy).

**24. As per claim 15:**

McCain further teaches:

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- the balance of the deferred income account and the deferred portions received into the deferred income account are not subject to a tax during a time at which the receiving step occurs (see at least paragraph 0016).

**25. As per claim 18:**

PLR further teaches:

- the method is governed by rules promulgated under authority of at least one source selected from the group consisting of: the first entity; a federal Indian Gaming Regulatory Act; a United States Bureau of Indian Affairs; a United States Department of the Interior; and a state compact (see at least page 1 paragraph 6 starting with “The information further states”).

**26. As per claims 22, 35, and 38:**

PLR further teaches:

- The plurality of monetary payments comprise a distribution from net revenues of at least one of a gaming operation of the Indian Tribe, a commercial operation of the Indian Tribe, or a sale or lease by the Indian Tribe of water, land, oil, timber, coal, sand, or gravel (see at least page 1 paragraph 6 starting with “The information further states”).

**27. As per claim 26:**

PLR further teaches:

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- If a qualified event has occurred, distributing a qualified portion of the balance of the deferred income account to the tribal member following a request of the tribal member (see at least page 1 paragraph 8 starting with “Under Plan A”).

**28. As per claim 27:**

PLR further teaches:

- The principal amount is a second portion of the balance of the deferred income account (see at least page 2 paragraph 5 starting with “Pursuant to authority”).

**29. As per claim 28:**

PLR further teaches:

- Using the first portion of the balance of the deferred income account to obtain the payout amount comprises: investing the first portion of the balance of the deferred income account (see at least page 2 paragraph 5 starting with “Pursuant to authority”).

**30. As per claim 29:**

PLR further teaches:

- Investing a third portion of the balance of the deferred income amount on behalf of the tribal member (see at least page 2 paragraph 5 starting with “Pursuant to authority”).

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**31. As per claim 37:**

PLR further teaches:

- The method is governed by a state compact (see at least page 3 paragraph 4 starting with "Section 1 of the Trust Agreement").

**32. Claims 12 and 32** are rejected under 35 U.S.C. 103(a) as being unpatentable over Private Letter Ruling 199908006 (PLR) in view of McCain, US 2002/0004771, in further view of Burgess, US Patent 5,966,693, in further view of Walker, US Patent 6,088,686.

**33. As per claims 12 and 32:**

PLR in view of McCain in view of Burgess teaches claim 10 as described above.

They do not teach a revolving line of credit. However, Walker teaches:

- the loan comprises a revolving line of credit (see at least column 9 line 56-57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a revolving line of credit as the loan described above in PLR in view of McCain in view of Burgess with motivation to provide many different commonly available loan options to best meet the needs of the customer.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuan Tran whose telephone number is 571-270-1832. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thuan Tran  
Patent Examiner  
5-22-2009

/Stefanos Karmis/  
Primary Examiner, Art Unit 3693